

Art Unit 2616
Serial No. 09/960,196

Reply to Office Action of: January 11, 2006
Attorney Docket No.: K35A0977

REMARKS

The Applicants thank the Examiner for his careful and thoughtful examination of the present application. By way of summary, Claims 1-10 were pending in this application. In the present amendment, the Applicants have made no amendments. Accordingly, Claims 1-10 remain pending for consideration.

REJECTION UNDER 35 USC § 103(a)

The Office action rejected Claims 1-2, 4-6 and 8-10 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 6,751,402, issued to Elliott *et al.* (the Elliott patent) in view of U.S. patent application publication no. 2002/0170073, to Miller *et al.* (the Miller reference). The Applicants respectfully traverse this rejection for the following reasons.

Applicants respectfully submit that the Elliott patent is not a valid prior art reference. The Office action uses the Elliott patent as a prior art reference under 35 U.S.C. § 103(a). However, 35 U.S.C. § 103(c) excludes references which may qualify as prior art under 35 U.S.C. § 102(e), (f), and (g) from being used as prior art references under 35 U.S.C. § 103(a).

The text of 35 U.S.C. § 103(c) recites: "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." See 35 U.S.C. § 103(c), MPEP 706.02(I)(1), 37 CFR § 1.104(c)(4).

The subject matter of the Elliott patent and the claimed present invention were, at the time the invention was made, commonly owned by or subject to an obligation of assignment to Western Digital Corporation, Inc. The listed assignees on the face of the Elliott patent are Keen Personal Media, Inc. and Keen Personal Technologies, Inc. (which two corporations are each wholly owned subsidiaries of Western Digital Corporation, Inc.), and assignments recorded in the present case on September 20,

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2001 list Keen Personal Media, Inc. as the assignee. Therefore, the Elliott patent and the claimed present invention were commonly owned, at the time the present invention was made, by Western Digital Corporation, Inc. See MPEP 706.02(I)(2) ("Example 1: Parent Company owns 100% of Subsidiaries A and B – inventions of A and B are commonly owned by the Parent Company"). The Elliott patent was filed on June 28, 2000 and published on June 15, 2004, whereas the above-referenced patent application was filed on September 20, 2001, such that the Elliott patent falls within the §103(c) exclusion.

Therefore, the Elliott patent is not a valid prior art reference and cannot be used to render obvious the embodiments of Applicants' present invention set forth in Claims 1-10.

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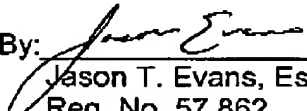
CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that the pending claims are now in condition for allowance and request reconsideration of the rejections. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to contact the undersigned attorney at the number listed below.

The Commissioner is hereby authorized to charge payment of any required fees associated with this Communication or credit any overpayment to Deposit Account No. 23-1209.

Respectfully submitted,

Date: March 24, 2006

By: 
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